

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHRISTIAN SCHADE, AXEL S. SANNER,
HANS-ULRICH WEKEL, FRANZ FROSCH and HORST WESTENFELDER

Appeal No. 1998-3101
Application 08/313,175

ON BRIEF

Before OWENS, TIMM and DELMENDO, *Administrative Patent Judges*.

OWENS, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal from the examiner's refusal to allow claims 1, 3 and 4 as amended after final rejection. Claims 5, 7 and 8, which are all of the other claims remaining in the application, stand withdrawn from consideration by the examiner as being directed toward a nonelected invention.

THE INVENTION

The appellants' claimed invention is directed toward a copolymer which, the appellants state, is useful as a thickener or dispersant in cosmetic, pharmaceutical and industrial applications (specification, page 8, lines 33-35). Claim 1 is illustrative and is appended to this decision.

THE REFERENCE

Snow et al. (Snow)	4,463,080	Jul. 31,
1984		

THE REJECTIONS

Claims 1, 3 and 4 stand rejected under 35 U.S.C. § 112, first and second paragraphs, on the grounds that the claimed invention is not described in such full, clear, concise and exact terms as to enable one of ordinary skill in the art to make and use the same, and/or for failing to particularly point out and distinctly claim the subject matter which the appellants regard as the invention,¹ and under 35 U.S.C. § 102(b) as anticipated

¹ In the examiner's answer, the rejections under 35 U.S.C. § 112, first and second paragraphs, are applied to claims 1-3. These grounds of rejection were applied to claims 1-4 in the final rejection (paper no. 8), and the examiner has given no

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by or, in the alternative, under 35 U.S.C. § 103 as obvious over Snow.

OPINION

We reverse the aforementioned rejections.

Rejection under 35 U.S.C. § 112, second paragraph

The examiner provides no reason whatsoever as to why he rejected the claims under 35 U.S.C. § 112, second paragraph. Accordingly, we reverse this rejection.

Rejection under 35 U.S.C. § 112, first paragraph

Regarding enablement, a predecessor of our appellate reviewing court stated in *In re Marzocchi*, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971):

[A] specification disclosure which contains a teaching of the manner and process of making and using the invention in terms which correspond in scope to those used in describing and defining the subject matter sought to be patented *must* be taken as in compliance with the enabling requirement of the first paragraph of § 112 *unless* there is reason to doubt the objective truth of the statements contained therein which must be relied on for

reason for withdrawing the rejections on these grounds as to claim 4. Thus, it reasonably appears that the examiner's answer should state that these rejections apply to claims 1, 3 and 4. We, therefore, consider the rejections to apply to each of these three claims.

enabling support. . . .

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. . . it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain *why* it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure.

The examiner argues that the specification does not provide guidelines which would have enabled one of ordinary skill in the art to make the broad class of polymers encompassed by the claims and to use them as thickeners and cosmetic additives (answer, pages 4-5).²

The examiner's assertion that the specification does not provide sufficient guidelines is not supported by the required evidence or reasoning. Particularly, the examiner does not address the discussion in the specification regarding how the quaternary ammonium compounds and copolymers are made (page 6,

² The examiner also argues: "Use of the term 'it also being possible....' has not fully described as directed to broad class of polymers" (answer, page 5). The examiner does not state, and we do not find, where this phrase, which is not in the claims, appears in the record.

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line 11 - page 8, line 32) and how the copolymers are used as thickeners or dispersants (page 8, line 33 - page 10, line 2), and does not address the appellants' thirty-six examples. Hence, we reverse the examiner's rejection under 35 U.S.C. § 112, first paragraph.

Rejection under 35 U.S.C. § 102(b)

In order for a claimed invention to be anticipated under 35 U.S.C. § 102(b), all of the elements of the claim must be found in one reference. *See Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991).

The examiner argues that "[i]nterpolymers containing monomers A), B), etc. have been disclosed by Snow, see column 2, line 50: [sic] column 3, line 33; column 6, line 37, etc." (answer, page 4). This is not an explanation of where each element of the claims is found in Snow. Consequently, we reverse the rejection under 35 U.S.C. § 102(b).

Rejection under 35 U.S.C. § 103

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Snow discloses a polymeric mordant having the structure shown in formula I (col. 2, lines 1-36). The appellants argue (brief, page 5) that they have provided calculations (amendment filed August 18, 1995, paper no. 7, page 3) which show that the maximum amount of component B in their copolymer is less than

15.6 mole%, and that the corresponding moiety in Snow's compound, which has the "y" subscript, must be present in an amount of about 20 mole% to about 100 mole% (col. 2, line 35).

The examiner does not challenge the appellants' calculations. The examiner argues that "about 20" is an approximate value which reasonably encompasses the value of 16.8 mole% (answer, pages 4-5). It is not apparent where the examiner got the number "16.8". Regardless, the examiner has provided no evidence as to how one of ordinary skill in the polymeric mordant art to which Snow is directed would have interpreted the term "about 20" mole%. The examiner's

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argument that it encompasses the amount used by the appellants is mere speculation, and such speculation is not a sufficient basis for a *prima facie* case of obviousness. See *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968); *In re Sporck*, 301 F.2d 686, 690, 133 USPQ 360, 364 (CCPA 1962). We therefore reverse the rejection under 35 U.S.C. § 103.

DECISION

The rejections of claims 1, 3 and 4 under 35 U.S.C. § 112, first and second paragraphs, and under 35 U.S.C. §§ 102(b) and 103 over Snow, are reversed.

REVERSED

TERRY J. OWENS)
Administrative Patent Judge)
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	CATHERINE TIMM)	BOARD OF
PATENT			
	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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	ROMULO H. DELMENDO)	
	Administrative Patent Judge)	

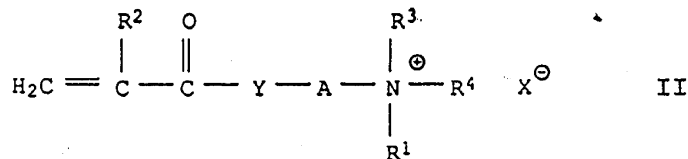
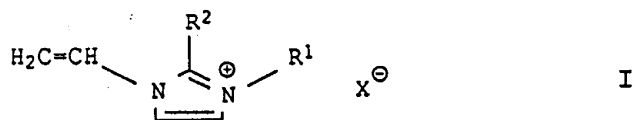
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APPENDIX

1. A copolymer obtained by free-radical polymerization of
 - A) 70-99.85% by weight of an olefinically unsaturated C₃-C₅-monocarboxylic acid, of an olefinically unsaturated C₄-C₈-dicarboxylic acid or the anhydride thereof or a mixture of such carboxylic acids or anhydrides with
 - B) 0.1-29.95 by weight of an olefinically unsaturated quaternary ammonium compound of the formula I or II



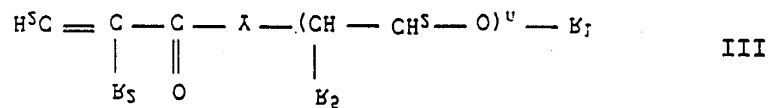
where

- R¹ is C₆-C₂₀-alkyl, C₆-C₂₀-alkenyl, C₅-C₈-cycloalkyl, phenyl, phenyl (C₁-C₁₂-alkyl) or (C₁-C₁₂-)phenyl,
- R² is hydrogen, methyl or phenyl,
- R³ and R⁴ are each H or C₁-C₄-alkyl,
- X is halogen, C₁-C₄-alkoxysulfonyloxy or C₁-C₄-alkanesulfonate, it also being possible for the latter to occur as R³ or R⁴ with the formation of a betaine structure,

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αποσπαιγνκει.

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- Ε) 0·2-38 ρλ μετδμφ οε ουε οτ ποτε σωηδονυα μτφ σφ ιεααφ φωο
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- Γ) 0 φο 3α·828 ρλ μετδμφ οε αν σελτςατε οτ μεφμσσελτςατε οε φρε
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